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M. Scott Reichardt

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EXAMINER

NGUYEN BA, HOANG VU A

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

| | | | |
|------------------------------|--|---|--|
| Office Action Summary | Application No. 10/618,154 | Applicant(s) REICHARDT ET AL. | |
| | Examiner Hoang-Vu A. Nguyen-Ba | Art Unit 2623 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 July 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-136 is/are pending in the application.
- 4a) Of the above claim(s) 1-84 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 85-136 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11 July 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>4/16/04, 1/17/07, 9/7/07</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This action is responsive to the preliminary amendment filed on July 11, 2003.
2. Per Applicants' request, the specification has been amended; Claims 1-84 have been canceled and new claims 85-136 have been added. Claims 85-136 have been examined. Claims 85, 98, 111 and 124 are independent claims.

Priority

3. The instant application is a continuation of application no. 09/731,115 which claims the priority date of the provisional application 60/170,060 filed on December 10, 1999. Therefore, the priority date for the instant application is December 10, 1999.

Oath/Declaration

4. The Office acknowledges receipt of a properly signed and dated declaration filed on July 11, 2003.

Information Disclosure Statement

5. The Office acknowledges receipt of the Information Disclosure Statements filed on April 16, 2004, January 17, 2007 and September 7, 2007. They have been placed in the application file and the information referred to therein has been considered.

Drawings

6. The drawings filed July 11, 2003 are objected by the examiner because of minor informalities: FIG. 13 contains a typographical error in block 1330 – the clause shown in this block needs a closing parenthesis at the end of the clause.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as “amended.” If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either “Replacement Sheet” or “New Sheet” pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

7. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant’s cooperation is requested in correcting any errors of which Applicant may become aware in the specification.

8. The specification is objected to because of the following minor informalities:
- a. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.
 - b. The use of trademarks, such as Microsoft's DCOM (p. 19, line 25), TV Guide (p. 36, line 23) has been noted in this application. Trademarks should be capitalized wherever they appear and be accompanied by the generic terminology.

Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in a manner which might adversely affect their validity as trademarks.

To expedite correction on this matter, the examiner suggests the following guidelines for Applicant to follow in amending the specification:

- i. capitalize each letter of a trademark or accompany the trademark with an appropriate designation symbol, e.g., TM or ®, as appropriate;
- ii. use each trademark as an adjective modifying a description noun. For example, it would be appropriate to recite "the JAVA platform" or "the JAVA programming language." Note that in these examples, "platform" and "programming language" provide accompanying generic terminology, describing the context in which the trademark is used. By itself, the trademark JAVA specifies only the source of the so-labeled products, namely SUN Microsystems, Inc.

Since, the application has disclosure of branded and unbranded items it is reasonable to direct Applicants' attention to the use of any registered trademark/tradename.

Claim Rejections – 35 USC § 102

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejection under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in

(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, or

(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for the purposes of this subsection of an application filed in the United States and was published under Article 21(2) of such treaty in the English language

10. Claims 85-94, 98-107, 111-120 and 124-133 are rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,177,931 to Alexander et al. (“Alexander”).

Claim 85

Alexander discloses at least *a method for presenting a user with a graphic advertisement in an interactive television program guide implemented on user television equipment, wherein television commercials and other television programming are transmitted to the user television equipment over a communications path from a distribution facility and are displayed for the user on the user television equipment, comprising:*

providing the user with an opportunity to access interactive television program guide information from the interactive television program guide (see at least FIG. 1, windows 14, 16; 10A-B; in FIGs. 10A and 10B, highlighted window; and 4:34-43; 26:14-29; 27:49-51)

by displaying an icon that indicates the availability of the interactive television program guide information (see at least FIG. 1, windows 14, 16; 10A-B; in FIGs. 10A and 10B, highlighted window; and 4:34-43; 26:14-29; e.g., the "i" icon) during the display of a television commercial associated with a given advertiser (see at least FIG. 1, windows 14, 16; 10A-B; in FIGs. 10A and 10B, highlighted window; and 4:34-43; e.g., the given advertiser is abc® or CBS® logo next to "Season Premier! in FIG. 10B); and

displaying the interactive television program guide information and a graphic advertisement associated with the given advertiser in the interactive television program guide for the user when the user accesses the interactive television program guide information in response to the icon (see at least FIG. 1, windows 14, 16; 10A-B; in FIGs. 10A and 10B, highlighted window; and 4:34-43; e.g., the given advertiser is abc® or CBS® logo next to "Season Premier! in FIG. 10B).

Claim 98

Claim 98 is an independent claim that recites a system (e.g., the television systems mentioned in 1:36-40) comprising means for performing the steps of the method claim 1. Thus, the rationale for rejection of Claim 1 also applies to Claim 98.

Claim 111

Alexander discloses at least *a system for presenting a user with a graphic advertisement in an interactive television program guide* (e.g., the television systems mentioned in 1:36-40) *comprising:*

a display device (see at least 1:36-40);

an input device (see at least FIG. 2); and

control circuitry (the control circuitry is deemed inherent to the television systems mentioned in 1:36-40; without this circuitry the television systems that

are interpreted to include set-top box, remote controller, etc., the display of the EPG and EPG and advertisement information would not be possible as shown in FIGs. 1-10B) *configured to perform the steps of the method claim 1.*

Thus, the rationale for rejection of Claim 1 also applies to Claim 111.

Claim 124

Claim 124 is an independent that recites *a computer readable medium encoded with machine-readable instructions* (e.g., the hardware components of the television systems mentioned in 1:26-40) *for use in performing the same steps of the method claim 1.* Thus, the rejection of Claim 1 also applies to Claim 124.

Claims 86, 99, 112 and 125

The rejection of respective base claim is incorporated. Alexander further discloses *wherein the television commercial and the graphic advertisement are both branded with the same brand, the method further comprising displaying the graphic advertisement branded with that brand on the user television equipment* (see at least FIGs. 10A-B; display of additional information concerning subject matter of a highlighted panel Ad window with brand or logo such as abc® and CBS®'s logo).

Claims 87, 100, 113 and 126

The rejection of respective base claim is incorporated. Alexander further discloses *retrieving the graphic advertisement from local memory* (see at least 4:34-43; 33:45-46; 34:10-16).

Claims 88, 101, 117 and 127

The rejection of respective base claim is incorporated. Alexander further discloses *retrieving the graphic advertisement from a remote server* (see at least 8:27-43; 33:45-47; 34:10-16).

Claims 89, 102, 114 and 128

The rejection of respective base claim is incorporated. Alexander further discloses *retrieving the graphic advertisement from local memory according to a schedule* (see at least 25:50 – 26:60).

Claims 90, 103, 118 and 129

The rejection of respective base claim is incorporated. Alexander further discloses *retrieving the graphic advertisement from a remote server according to a schedule* (see at least 8:18-64; 25:50 – 26:60; 33:21-24).

Claims 91, 104, 115 and 130

The rejection of respective base claim is incorporated. Alexander further discloses *retrieving the graphic advertisement from local memory in response to a real-time flag in the commercial* (see at least 8:18-64; 14:47 – 15:31; 33:21-24; 33:21-24).

Claims 92, 105, 119 and 131

The rejection of base claim is incorporated. Alexander further discloses *retrieving the graphic advertisement from a remote server in response to a real-time flag in the commercial* (see at least 8:18-64 and 14:47 – 15:31; 33:21-24; 33:43-47).

Claims 93, 106, 116 and 132

The rejection of base claim is incorporated. Alexander further discloses *retrieving the graphic advertisement from local memory in response to a real-time vertical-blanking-interval flag in the commercial* (see at least 8:18-64; 33:21-24; 33:21-24).

Claims 94, 107, 120 and 133

The rejection of base claim is incorporated. Alexander further discloses *retrieving the graphic advertisement from a remote server in response to a real-time vertical-blanking-interval flag in the commercial* (see at least 8:18-64; 14:47 – 15:31; 33:21-24; 33:43-47).

Claim Rejections - 35 USC § 103

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. Claims 95-97, 108-110, 121-123 and 134-136 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,177,931 to Alexander et al. (“Alexander”), as applied the respective base claim, in view of U.S. Patent No. 5,589,892 to Knee et al. (“Knee”).

Claims 95, 108, 121 and 134

Alexander does not specifically disclose the feature of Claims 95, 108, 121 and 134.

However, in an analogous art, Knee discloses *enabling the user to purchase a product or service using the interactive television program guide* (see at least FIGs. 43B-E and 44).

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to use the feature Knee in Alexander because this would provide means for a user to conveniently purchase products or services advertised in windows 14 and 16 of FIG. 1 and in highlighted windows of FIGs. 10A-B of Alexander, thereby providing users with more incentives to purchase products or services while watching television and thus increasing e-commerce.

Claims 96, 109, 122 and 135

Alexander does not specifically disclose the feature of Claims 96, 109, 122 and 135.

However, in an analogous art, Knee discloses *enabling the user to purchase a product or service using the interactive television program guide by displaying a point-of-sale window having information on the product or service in response to a user input when the icon is displayed* (see at least FIGs. 43B-E and 44).

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to use the feature Knee in Alexander because this would provide means for a user to conveniently purchase products or services advertised in windows 14 and 16 of FIG. 1 and in highlighted windows of FIGs. 10A-B of Alexander, thereby providing users with more incentives to purchase products or services while watching television and thus increasing e-commerce.

Claims 97, 110, 123 and 136

Alexander does not specifically disclose the feature of Claims 97, 110, 123 and 136.

However, in an analogous art, Knee discloses *enabling the user to purchase a product or service using the interactive television program guide by displaying a point-of-sale window having information on the product or service in response to a user input when the icon is displayed, wherein the point-of-sale window also provides access to other products or services* (see at least FIGs. 43B-E and 44).

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to use the feature Knee in Alexander because this would provide means for a user to conveniently purchase products or services advertised in windows 14 and 16 of FIG. 1 and in highlighted windows of FIGs. 10A-B of Alexander, thereby providing users with more incentives to purchase products or services while watching television and thus increasing e-commerce.

Conclusion

13. The prior art made of record and not relied upon is considered pertinent to Applicant's disclosure.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hoang-Vu "Antony" Nguyen-Ba whose telephone number is (571) 272-3701. The examiner can normally be reached on Tuesday-Friday from 7:00 am to 5:30 pm.

If attempts to reach the examiner are unsuccessful, the examiner's supervisor, John Miller can be reached at (571) 272-7353.

The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Any inquiry of a general nature or relating to the status of this application should be directed to the TC 2600 Group receptionist (571) 272-2600.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at (866) 217-9197 (toll-free).

/Hoang-Vu Antony Nguyen-Ba/

Primary Examiner, Art Unit 2623

March 10, 2008